

### **REMARKS**

In view of the following remarks, the Examiner is requested to allow Claims 1-10 and 26-27, the only claims pending and under examination in this application.

#### ***Claim Rejections – 35 U.S.C. § 102***

Claims 1-8 and 26-27 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Cronin et al. (U.S. Publication No. 2006/0229824).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

The Applicants submit that the Cronin '260 application (hereinafter "Cronin") does not anticipate the rejected claims because Cronin fails to disclose every element of the Applicants' claims. Specifically, the Applicants contend that Cronin fails to disclose the claimed element of information for decoding encoded array information obtained from an array comprising one or more array information features.

According to the Federal Circuit, a person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005). See also *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005) ("We cannot look at the ordinary meaning of the term . . . in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history."); *V-Formation, Inc. v. Benetton Group SpA*, 401 F.3d 1307, 1310 (Fed. Cir. 2005) (the intrinsic record "usually provides the technological and temporal context to enable the court to ascertain the meaning of the claim to one of ordinary skill in the art at the time of the invention").

As can be see with reference to the definitions section of the Applicants' specification, "Array information is distinct from sample or target information because array information yields no relevant information about sample or targets, except for targets that bind to the array information features present in a sample". See Patent Specification, pg. 13, lines 20-22. Thus according to the Applicants' specification,

“array information” as recited in the claims, refers to information about the array, rather than information about the sample hybridized to the array. Such array information may be, for example, the format of the array, or the type of polynucleotides that are present on the array. Such information is different to target information.

Cronin’s disclosure is deficient in that the arrays are not coded about the arrays themselves.

The Examiner alleges that Cronin teaches identifying the target through decoding information obtained from an array hybridization. See August 22, 2007 Office Action, pg. 3, ¶ 4. In maintaining the rejection, the Examiner cites to paragraph [0138] of Cronin, which states, “When a target is hybridized to the pools, only those pools comprising a component probe having a segment that is exactly complementary to the target light up. The identity of the target is then decoded from the pattern of hybridizing pools.” This information is not information about the array, per se. Rather, the information provided by the array in Cronin is information about the target sequence. Thus, Cronin fails to disclose the claimed element of information for decoding encoded array information obtained from an array comprising one or more array information features.

Consequently, the Applicants contend that Cronin does not anticipate the rejected claims. This rejection may be withdrawn for this reason alone.

The Examiner further alleges that Cronin (U.S. Publication No. 2006/0229824) has an effective filing date of May 1, 2002, which is for U.S. Publication No. 2003/0165830 from U.S. Application No. 09/798,260.

The Applicants contend that although Cronin purports to claim priority to the ‘260 application, filed May 1, 2002, the subject matter of Claim 31 was introduced into the specification on its date of filing, which was March 3, 2006. The subject matter of Cronin’s Claim 31 is not supported by the specification of the ‘260 application.

Hence, because the Examiner is relying on the subject matter of Claim 31 to support its position, and because the subject matter of Claim 31 constitutes new matter that was introduced into the Cronin application on March 3, 2006, which is after the Applicants’ date of filing, the subject matter of Claim 31 may not be relied

upon to anticipate the rejected claims. Accordingly, the Applicants contend that Cronin does not anticipate the Applicants' claims because the subject matter relied upon by the Examiner is not prior art to the Applicants' claims. Consequently, the Applicants respectfully request that the 35 U.S.C. § 102(e) rejection of Claims 1-8 and 26-27 be withdrawn.

### ***Claim Rejections – 35 U.S.C. § 103***

Claim 9 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cronin et al. (U.S. Publication No. 2006/0229824), and further in view of Cool (U.S. Patent No. 6,912,469).

In order to meet its burden in establishing a rejection under 35 U.S.C. § 103 the Office must first demonstrate that the combined prior art references teach or suggest all the claimed limitations. See *Pharmastem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342 (Fed. Cir. 2007) ("the burden falls on the patent challenger to show by clear and convincing evidence that a person of ordinary skill in the art would have had reason to attempt to make [every element of] the composition or device, or carry out the [entire] claimed process, and would have had a reasonable expectation of success in doing so," (citing *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007))); and see *Omegaflex, Inc. v. Parker-Hannifin Corp.*, 2007 U.S. App. LEXIS 14308 (Fed. Cir. 2007) ("[t]he Supreme Court recently explained that 'a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art,'" (citing *KSR Int'l Co.* at 1741)); and see *Dystar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006) ("[once] all claim limitations are found in a number of prior art references, the factfinder must determine '[w]hat the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references,'" (citing *In re Fulton*, 391 F.3d 1195, 1199-1200 (Fed. Cir. 2004))).

As set forth above, Cronin fails to disclose the claimed element of information for decoding encoded array information obtained from an array comprising one or more array information features. The Applicants respectfully submit that Cronin also fails to suggest this element because the information provided by the array in Cronin is information about the target sequence, not information about the array. Thus,

Cronin fails to disclose or suggest information for decoding encoded array information obtained from an array comprising one or more array information features, as claimed by the Applicants.

Moreover, as described above, the subject matter relied upon in Cronin for supporting this rejection does not constitute prior art to the Applicants' claims. Accordingly, because Cronin does not constitute prior art, the Applicants contend that a *prima facie* case of obviousness has not been established. Thus, this rejection may be withdrawn.

Cool was cited solely for its alleged disclosure of encoding binary coded information as binary ASCII code. As such, Cool fails to remedy the deficiencies of Cronin.

Therefore, for the reasons stated above, a *prima facie* case of obviousness has not been established. Accordingly, the Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claim 9 be withdrawn.

Claim 10 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cronin et al. (U.S. Publication No. 2006/0229824), and further in view of Hu et al. (U.S. Publication No. 2004/0248287).

As described above, the subject matter relied upon in Cronin for supporting this rejection does not constitute prior art to the Applicants' claims. Accordingly, because Cronin does not constitute prior art, the Applicants contend that a *prima facie* case of obviousness has not been established. Thus, this rejection may be withdrawn.

Moreover, as discussed above, Cronin fails to disclose or suggest the claimed element of information for decoding encoded array information obtained from an array comprising one or more array information features. Since Hu was cited only for its alleged disclosure of the use of multi-arrays, Hu fails to make up for the deficiencies in Cronin. As such, this rejection may be withdrawn.


**CONCLUSION**

In view of the amendments and remarks above, Applicant(s) respectfully submit(s) that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone John Brady at (408) 553-3584.

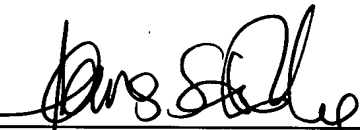
The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078.

Respectfully submitted,

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